

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Haces, Alberto

Application No. 10/762,914

Filed: January 21, 2004

For: **Highly Packed Polycationic  
Ammonium, Sulfonium and  
Phosphonium Lipids**

Confirmation No. 6157

Group Art Unit: 1616

Atty. Docket No. IVGN 114.5

Customer No. 52059

Examiner: Webman, Edward J

**Response to Restriction Requirement and Election of Species**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement set forth in the Office Action mailed May 2, 2007, Applicants hereby elect Group I (claims 1-5, 7-10, 12-13, 15-16 and 18-19), with traverse. This election of claims is made without prejudice to Applicants' right to pursue the non-elected claims in one or more divisional applications in due course.

The Examiner classified the claims into two groups. According to the Office Action, Group I, consisting of claims 1-5, 7-10, 12-13, 15-16 and 18-19, is related as a product and Group II, consisting of claims 6, 11, 14, 17 and 20 is related as a process of use. *Office Action of May 2, 2007, page 2.*

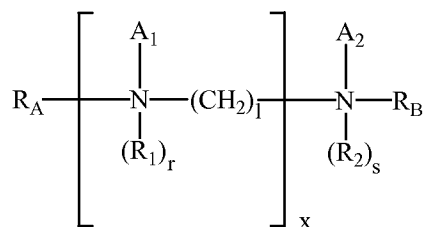
To sustain a proper requirement for restriction, the Examiner must demonstrate that the independent and distinct inventions meet *two* criteria. First, the "inventions must be independent or distinct ... as claimed", and second, there *must* be a *serious burden* on the Examiner if restriction is not required. The Examiner can demonstrate a "serious burden" by "appropriate explanation of separate classification, or separate status in the art, or a different field of search...". *MPEP* §803.

In making the restriction, the Office Action classifies claims 1-20 into 2 groups and states that Groups I-II are unrelated because “inventions I and II are related as product and process of use.” *Office Action of May 2, 2007, page 2*. But to sustain a proper restriction requirement, there must be a serious burden on the Examiner, and this serious burden can be explained by “appropriate explanation of separate classification.” Applicants respectfully assert that the Class 526 (designated for Group I) provides for all processes of preparing polymers from only ethylenically unsaturated monomers and for all products thereof. The Applicants respectfully assert that pending claims 1-20 are not product by process claims and therefore the Applicants believe the use of Class 526 is inappropriate. The Examiner has classified Group II in Class 424/78.35, and the Applicants believe that Group I would be more appropriately classified in Class 514 as Class 514 is considered to be an integral part of Class 424 and retains all pertinent definitions and class lines of Class 424. Therefore, the Applicants respectfully assert that this would not be a burden on the Examiner if restriction was not required. Accordingly, Applicants assert that there is no serious burden in searching the claims of Groups I-II, and restriction is improper.

In summary, Applicants assert that searching Groups I-II of the invention would not pose a serious burden on the Examiner. Reconsideration of the restriction requirement is therefore requested.

### **The Election Requirement**

The Examiner has required an election of a single disclosed species. Applicants elect the species of formula:



where:

x is 3;

l is 3;

r and s are 1;

R<sub>A</sub> and R<sub>B</sub> are hydroalkyl groups having 1 to 6 carbon atoms, specifically R<sub>A</sub>  
and R<sub>B</sub> are each -CH<sub>2</sub>-CH<sub>2</sub>-OH;

R<sub>1</sub> and R<sub>2</sub> are alkyl groups having 1 to 6 carbon atoms, specifically R<sub>1</sub> and R<sub>2</sub>  
are each -CH<sub>3</sub>;

A<sub>1</sub> and A<sub>2</sub> are -CH(D-L)<sub>2</sub>, specifically D is -CO- and L is a C<sub>16</sub> straight chain  
alkyl.

Claims 1-6 read on the elected species. This election is made with traverse because claim  
1 is believed to be an allowable generic claim which links the species.

### **Conclusion**

In view of the election filed herewith, Applicants respectfully submit that all of  
the pending claims are in condition for allowance. It is believed that no fees are required  
in connection with this filing. However, if additional extensions of time are necessary to  
prevent abandonment of this application, then such extensions of time are hereby  
petitioned under 37 C.F.R. § 1.136(a), and any fees required therefore are hereby  
authorized to be charged to Deposit Account No. 50-3994.

If the Examiner believes, for any reason, that personal communication will  
expedite prosecution of this application, the Examiner is invited to telephone the  
undersigned at the number provided.

Respectfully submitted,

Date June 1, 2007

/Daniel E. Raymond, Reg. # 53,504/

Daniel E. Raymond

Invitrogen Corp.  
1600 Faraday Ave.  
Carlsbad, CA 92008  
(760) 268-7498